

REMARKS

I. Introduction

Claims **19, 23, 26, 28-29, 49, and 53-83** are currently pending in the present application. Independent claims **82-83** have been withdrawn from consideration pursuant to a Restriction Requirement and subsequent provisional election, made final by the Examiner in the Office Action. Office Action, pg. 2, paragraphs 2-3. Of the claims remaining for consideration, claims **19, 49, 53, 64, 72, 76, and 80-81** are independent.

All claims remaining for consideration (claims **19, 23, 26, 28-29, 49, and 53-83**) stand rejected solely under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 4,654,800 (hereinafter “Hayashi”) in view of U.S. Patent No. 5,780,133 (hereinafter “Engstrom”).

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Incomplete Office Action

Applicants respectfully note that it is required that “[t]he examiner’s action will be complete as to all matters.” 37 C.F.R. §1.104(b), MPEP §707.07. Also, “[t]he *pertinence of each reference*, if not apparent, *must be clearly explained* and each rejected claim specified.” 37 C.F.R. §1.104(c)(2); emphasis added. More specifically, “[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, *stating the reasons for such rejection*, or objection or requirement, *together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application*; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.” 35 U.S.C. §132(a); emphasis added.

In this case, Applicants respectfully submit that the rejections set forth by the Office Action in association with many claimed limitations are uninformative to the extent that Applicants’ ability to recognize and counter the grounds for rejection is

substantially hindered. Applicants note, for example, that the Office Action appears to be incomplete in that many claim limitations are not directly addressed in the rejections as set forth. Nowhere, for example, does the Examiner appear to address any of the following limitations:

(i) *the processor being operative with the program in the memory to select the first product from among the plurality of products after determining whether the consumer accepts the offer (claim 55);*

(ii) *the processor being operative with the program in the memory to select the first product from among the plurality of products before determining whether the consumer accepts the offer (claim 56);*

(iii) *in which the selected first product has the lowest profit margin among the plurality of products (claim 57);*

(iv) *in which the selected first product has the highest profit margin among the plurality of products (claim 58);*

(v) *in which the offer does not disclose a trademark of any of the combination of products (claim 60);*

(vi) *wherein the offer comprises an indication of a category associated with the mystery product (claim 65);*

(vii) *wherein the data associated with the mystery product comprises a stock date of the mystery product (claims 67 and 71);*

(viii) *wherein the data associated with the mystery product comprises an inventory of the mystery product (claim 69 and 71);*

(ix) *displaying, via a display device of a vending machine, an offer for a mystery product, wherein the offer only identifies a category associated with the mystery product and a mystery product price associated with the mystery product (claims 72-75);*

(x) *wherein the category comprises a “snack” category (claim 73);*

(xi) *wherein the category comprises a “drink” category (claim 74);*

(xii) *selecting, by the processing device, the mystery product from a plurality of available products offered for sale by the vending machine, wherein the mystery product is selected from a subset of the available products that are associated with the displayed category (claim 75);*

(xiii) *displaying, via a display device of a vending machine, an offer for a mystery package comprising a first mystery product and a second mystery product, wherein the offer only identifies (i) a first category associated with the first mystery product, (ii) a second category associated with the second mystery product, and (iii) a mystery package price associated with the mystery package (claims 76-79);*

(ix) *selecting, by the processing device, the first mystery product from a first subset of a plurality of available products offered for sale by the vending machine, the first subset being associated with the first category (claim 77);*

(x) *selecting, by the processing device, the second mystery product from a second subset of a plurality of available products offered for sale by the vending machine, the second subset being associated with the second category (claim 77);*

(xi) *wherein the first and second categories are different (claims 78-79);*

(xii) *wherein the first category comprises a “snack” category and wherein the second category comprises a “drink” category (claim 79);*

(xiii) *receiving, by a vending machine, an indication of a product category that defines a subset of products offered for sale by the vending machine, the product category being selected by a consumer (claim 80);*

(xiv) *selecting, by a processing device of the vending machine, and based on the product category selected by the consumer and the monetary amount provided by the consumer, a mystery product associated with the product category, wherein a minimum price associated with the mystery product is less than or equal to the monetary amount provided by the consumer (claim 80); or*

(xv) *offering the identified product to the consumer as a mystery product in exchange for the amount of change due to the consumer (claim 81).*

Applicants respectfully note that 35 U.S.C. §132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection. See, e.g., *In re Wilke*, 50 C.C.P.A. 964, 314 F.2d 558, 562, 136 USPQ 435, 439 (1963).” *Chester v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990). In this case, the Office Action generally lacks information anywhere in the record that permits Applicants to guess, with respect to the above-quoted claims and/or limitations: (i) the substance or basis for the Examiner's interpretation of the claims and/or claim terms, (ii)

whether the Examiner has inadvertently ignored certain claims and/or claim limitations, and/or (iii) what portions of which (if any) of the cited references the Examiner believes explicitly disclose what portions of the claims.

Accordingly, as the Office Action is incomplete and fails to allow Applicants to effectively counter *many* of the outstanding rejections as set forth, in contravention of 35 U.S.C. §132, 37 C.F.R. §1.104, and MPEP § 707.07, Applicants respectfully request that a new Non-final Office Action clarifying the current rejections, properly reflecting the status of all claims, and properly addressing all rejected claims and claim limitations, be provided in response to this paper.

III. Failure to Respond to Applicants' Arguments

Applicants respectfully note that when an “applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument *and answer the substance of it.*” MPEP §707.07(f); emphasis added. Applicants further point out that the “Examiner’s Note” that provides instructions for use of the Form Paragraph that reads “Applicant's arguments with respect to claim [1] have been considered but are moot in view of the new ground(s) of rejection” states that “[t]he examiner *must, however, address any arguments presented by the applicant* which are still relevant to any references being applied.” *Id.*; emphasis added.

In this case, the Examiner has made *no attempt* to address Applicants previous arguments. In as much as those previous arguments are relevant to the new grounds of rejection, the Examiner *must* address those arguments. *Id.* In this case, the new ground of rejection is substantially based on a reference (Hayashi) and alleged teachings of that references that have already been addressed in Applicants’ previous arguments – which have not been addressed by the Examiner in the Office Action. The Examiner must, therefore, respond to Applicants’ arguments with respect to the alleged teachings of Hayashi, as set forth in Applicants’ Amendment and Response mailed on June 9, 2006, and particularly, Section II thereof.

Accordingly, Applicants respectfully request that the Examiner address all of Applicants’ arguments, as required by MPEP §707.07, in a subsequent Non-Final Office Action.

IV. The Examiner's Rejections: 35 U.S.C. §103(a) - Hayashi, Engstrom

Claims 19, 23, 26, 28-29, 49, and 53-83 stand rejected solely under 35 U.S.C. §103(a) as being allegedly unpatentable over Hayashi in view of Engstrom. As described in Section III herein, the Examiner has failed to respond to Applicants' most recent arguments in relation to the alleged teachings of the Hayashi reference. Accordingly, Applicants hereby incorporate those arguments herein and respectfully direct the Examiner's attention to those arguments submitted in Applicants' previous response submitted on June 9, 2006, and particularly, to Section II thereof. Applicants further respectfully traverse this ground for rejection as follows.

A. The references fails to teach or suggest: *an automatic sales machine operable to select a product from among the plurality of products based on the monetary value and the minimum acceptable price data AND output via an output device an offer of the product to a consumer* (claims 19, 23, 26, 28-29, 49)

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claims 19, 23, 26, 28-29, and 49. For example, Hayashi and Engstrom fail to teach or suggest *an automatic sales machine operable to select a product from among the plurality of products based on the monetary value and the minimum acceptable price data AND output via an output device an offer of the product to a consumer*.

Applicants respectfully note that Hayashi generally describes a vending machine that is operable to store certain sales data associated with the vending machine, display such data to an operator of the vending machine via an "operation panel 5", and allow the operator to input, change, and/or clear such data. Hayashi, Col. 1, line 21 to Col. 2, line 31. These functions are described as being relevant to allowing "sales management" to be "efficiently performed" (Hayashi, Col. 10, line 23), and making delivery schedules and/or product stocking or deliveries more efficient and/or precise (Hayashi, Col. 2, lines 5-9). With respect to actual sales processes at the vending machine in Hayashi, Hayashi describes (i) a "continuous selling mode" (Hayashi, Col. 3, 58-61; Col. 7, lines 1-4), (ii) "group selling" (Hayashi, Col. 3, lines 62-65; Col. 7, lines 24-27), (iii) a "throw-in sale"

(Hayashi, Col. 4, lines 6-8; Col. 7, line 66 to Col. 8, line 31), and (iv) a “discount sale” (Hayashi, Col. 3, line 66 to Col. 4, line 6; Col. 8, lines 32-59). None of these selling modes or actions are described in detail in Hayashi, nor does v describe in detail any interactions with customers. Instead, Hayashi is primarily and vastly directed to interactions between an operator and the vending machine, such as in relation to a stocking procedure of the vending machine.

Applicants respectfully note that while Hayashi may allow an operator of the vending machine to utilize the “operation panel 5” to view and select product information and therefore ‘select’ or choose different products/columns based on such information, nowhere does Hayashi describe an automatic sales machine (e.g., the vending machine) being operable to perform such functions. In other words, Hayashi contemplates providing such information to an operator so that the operator can use such information to perform “sales management” and thus better determine how the vending machine should be stocked to benefit sales. In contrast, the vending machine of the currently claimed embodiments of claims **19**, **23**, **26**, **28-29**, and **49** is operable to automatically select products to offer for sale (e.g., products that are already stocked in the machine) to customer, based on such information. Hayashi simply does not contemplate, teach, or suggest such functionality. Indeed, the espoused novelty of Hayashi appears to be the basic ability to even allow such information to be stored and presented to the operator to facilitate machine stocking. Hayashi, Col. 1, lines 5-20.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *an automatic sales machine operable to select a product from among the plurality of products based on the monetary value and the minimum acceptable price data AND output via an output device an offer of the product to a consumer*, Hayashi and Engstrom fail to render obvious claims **19**, **23**, **26**, **28-29**, and **49**. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **19**, **23**, **26**, **28-29**, and **49** be withdrawn.

B. The references fails to teach or suggest: *wherein the processor is further operative with the program in the memory to determine whether the monetary value is at least as great as the lowest minimum acceptable price, and to offer the product performed only upon determining that the monetary value is at least as great as the lowest minimum acceptable price (claim 26)*

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claim 26. For example, Hayashi and Engstrom fail to teach or suggest *wherein the processor is further operative with the program in the memory to determine whether the monetary value is at least as great as the lowest minimum acceptable price, and to offer the product performed only upon determining that the monetary value is at least as great as the lowest minimum acceptable price.*

As described in Section IV.A herein, Hayashi simply does not provide much description of sales processes at a vending machine, since Hayashi is primarily directed to facilitating vending machine stocking. As such, Hayashi simply fails to describe or disclose any non-standard vending machine sales procedures. In other words, while Hayashi may describe offering products for sale to customers, Hayashi certainly does not describe offering a product only if an input monetary value is at least as great as the lowest minimum acceptable price. While Hayashi may describe a standard vending machine that offers static offers for all products stocked in the vending machine, for example, nowhere does Hayashi contemplate *selective* offering of such products, much less such selective offering being based on a comparison of coin-in to minimum acceptable prices.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *wherein the processor is further operative with the program in the memory to determine whether the monetary value is at least as great as the lowest minimum acceptable price, and to offer the product performed only upon determining that the monetary value is at least as great as the lowest minimum acceptable price,*

Hayashi and Engstrom fail to render obvious claim 26. Applicants therefore respectfully request that this §103(a) ground for rejection of claim 26 be withdrawn.

C. **The references fails to teach or suggest:** *wherein the database further includes expiration data for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the expiration data* (claim 28; and generally, claims 61, 66, and 71)

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claims 28, 61, 66, and 71. For example, Hayashi and Engstrom fail to teach or suggest *wherein the database further includes expiration data for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the expiration data*.

The Examiner states that Hayashi “teaches databases further includes [sic] expiration data for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the expiration data.” Office Action, pg. 4, last paragraph.

Applicants respectfully note that the word “expiration” does not even occur in the Hayashi reference. Review of the portion of Hayashi cited by the Examiner in support of the Examiner’s assertion that Hayashi teaches “expiration data” reveals only that Hayashi describes how to handle dispensing errors due to product jams in the machine. Nor does any other portion of Hayashi appear to contemplate the claimed limitation.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *wherein the database further includes expiration data for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the expiration data*, Hayashi and Engstrom fail

to render obvious claims **28, 61, 66, and 71**. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **28, 61, 66, and 71** be withdrawn.

D. The references fails to teach or suggest: *wherein the database further includes **profitability data** for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the profitability data* (claim **29**; and generally, claims **53, 61, 63, and 70-71**)

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claims **29, 53, 61, 63, and 70-71**. For example, Hayashi and Engstrom fail to teach or suggest *wherein the database further includes **profitability data** for each of the plurality of products and wherein the processor is further operative with the program in the memory to select the product based on the profitability data*.

As described in Section IV.A and Section IV.B herein, Hayashi simply fails to describe the processor of the vending machine selecting products based on stored data – any such selecting is instead performed by an operator of the vending machine, which is associated with an entirely different context than the embodiments of the currently pending claims. In other words, while the operator in Hayashi may review products based on sales data and use such data in determining how to best stock the vending machine, nowhere does Hayashi contemplate the machine utilizing such information to pick which stocked products to offer to customers. Even if Hayashi did teach or suggest the vending machine *selectively offering* stocked products to customers (which Applicants maintain is not the case), nowhere does Hayashi describe storing “profitability data” or using such data to select the products to offer to customers.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *wherein the database further includes **profitability data** for each of the plurality of products and wherein the processor is further operative with the program*

in the memory to select the product based on the profitability data, Hayashi and Engstrom fail to render obvious claims 29, 53, 61, 63, and 70-71. Applicants therefore respectfully request that this §103(a) ground for rejection of claims 29, 53, 61, 63, and 70-71 be withdrawn.

E. The references fails to teach or suggest: *determine respective **demand data** for each of the plurality of products AND in which the processor is operative with the program in the memory to select, based on the respective **profit margin** and the respective **demand data** for each of the plurality of products, the first product from among the plurality of products (claim 62)*

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claim 62. For example, Hayashi and Engstrom fail to teach or suggest *determine respective **demand data** for each of the plurality of products AND in which the processor is operative with the program in the memory to select, based on the respective **profit margin** and the respective **demand data** for each of the plurality of products, the first product from among the plurality of products.*

As described in Section IV.A, Section IV.B, and Section IV.D herein, Hayashi simply fails to describe the processor of the vending machine selecting products based on stored data. Even if Hayashi did teach or suggest the vending machine *selectively offering* stocked products to customers (which Applicants maintain is not the case), nowhere does Hayashi describe the vending machine determining “demand data” (much less “profit margin” data) or using such data to select the products to offer to customers, much less using both “demand data” and “profit margin” data to select products to offer to customers.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *determine respective **demand data** for each of the plurality of products AND in which the processor is operative with the program in the memory to*

*select, based on the respective **profit margin** and the respective **demand data** for each of the plurality of products, the first product from among the plurality of products, Hayashi and Engstrom fail to render obvious claim 62. Applicants therefore respectfully request that this §103(a) ground for rejection of claim 62 be withdrawn.*

F. The references fails to teach or suggest: *automatically determine **revenue data** associated with the plurality of products OR in which the processor is operative with the program in the memory to select, based on the respective **profit margin** for each of the plurality of products and the **revenue data**, the first product from among the plurality of products (claim 63)*

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claim 63. For example, Hayashi and Engstrom fail to teach or suggest *automatically determine **revenue data** associated with the plurality of products OR in which the processor is operative with the program in the memory to select, based on the respective **profit margin** for each of the plurality of products and the **revenue data**, the first product from among the plurality of products.*

As described in Section IV.A, Section IV.B, Section IV.D, and Section IV.E herein, Hayashi simply fails to describe the processor of the vending machine selecting products based on stored data. Even if Hayashi did teach or suggest the vending machine *selectively offering* stocked products to customers (which Applicants maintain is not the case), nowhere does Hayashi describe the vending machine determining “revenue data” (much less “profit margin” data) or using such data to select the products to offer to customers, much less using both “revenue data” and “profit margin” data to select products to offer to customers.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *automatically determine **revenue data** associated with the plurality of products OR in which the processor is operative with the program in the memory to select, based on the respective **profit margin** for each of the plurality of products and the*

revenue data, the first product from among the plurality of products, Hayashi and Engstrom fail to render obvious claim 63. Applicants therefore respectfully request that this §103(a) ground for rejection of claim 63 be withdrawn.

G. The references fails to teach or suggest: *wherein the data associated with the mystery product comprises a **sales rate** of the mystery product (claims 68 and 71)*

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claims 68 and 71. For example, Hayashi and Engstrom fail to teach or suggest *wherein the data associated with the mystery product comprises a **sales rate** of the mystery product.*

As described in Section IV.A, Section IV.B, Section IV.D, Section IV.E, and Section IV.F herein, Hayashi simply fails to describe the processor of the vending machine selecting products based on stored data. Even if Hayashi did teach or suggest the vending machine *selectively offering* stocked products to customers (which Applicants maintain is not the case), nowhere does Hayashi describe the vending machine determining a “sales rate” or using the “sales rate” to select the products to offer to customers.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *wherein the data associated with the mystery product comprises a **sales rate** of the mystery product*, Hayashi and Engstrom fail to render obvious claims 68 and 71. Applicants therefore respectfully request that this §103(a) ground for rejection of claims 68 and 71 be withdrawn.

H. The references fails to teach or suggest: *displaying, via a display device of a vending machine, an offer for a **mystery package** comprising a first mystery product and a second mystery product, wherein the offer only identifies (i) a first category associated with the first mystery product, (ii) a second category*

associated with the second mystery product, and (iii) a mystery package price associated with the mystery package (claims 76-79)

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claims 76-79. For example, Hayashi and Engstrom fail to teach or suggest *displaying, via a display device of a vending machine, an offer for a **mystery package** comprising a first mystery product and a second mystery product, wherein the offer only identifies (i) a first category associated with the first mystery product, (ii) a second category associated with the second mystery product, and (iii) a mystery package price associated with the mystery package.*

Simply nowhere does Hayashi describe offering **packages of products** to customers, much less only identifying categories of the products available in the packages in such offers for the packages.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *displaying, via a display device of a vending machine, an offer for a **mystery package** comprising a first mystery product and a second mystery product, wherein the offer only identifies (i) a first category associated with the first mystery product, (ii) a second category associated with the second mystery product, and (iii) a mystery package price associated with the mystery package*, Hayashi and Engstrom fail to render obvious claims 76-79. Applicants therefore respectfully request that this §103(a) ground for rejection of claims 76-79 be withdrawn.

I. The references fails to teach or suggest: *receiving, by a vending machine, an indication of a selection of a product by a consumer* (claim 81)

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claim 81. For example, Hayashi and Engstrom fail to teach or suggest *receiving, by a vending machine, an indication of a selection of a product by a consumer.*

As an indication of how little the Hayashi reference describes with reference to sales procedures at the vending machine, and thus how irrelevant Hayashi is to the pending claims in general, Applicants respectfully note that Hayashi does not even describe receiving a customer selection of a product offered for sale by the vending machine.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *receiving, by a vending machine, an indication of a selection of a product by a consumer*, Hayashi and Engstrom fail to render obvious claim **81**. Applicants therefore respectfully request that this §103(a) ground for rejection of claim **81** be withdrawn.

J. The references fails to teach or suggest: *identifying a product offered for sale by the vending machine that is associated with a minimum acceptable price that is less than or equal to the amount of change due to the consumer* (claim **81)**

Applicants respectfully assert that neither Hayashi nor Engstrom teaches or suggests, alone or in combination, limitations of claim **81**. For example, Hayashi and Engstrom fail to teach or suggest *identifying a product offered for sale by the vending machine that is associated with a minimum acceptable price that is less than or equal to the amount of change due to the consumer*.

Applicants respectfully note that Hayashi simply does not describe, anywhere, identifying products based on an amount of change due to the customer. In contrast, claim **81** describes identifying products based on the amount of change due, such that these products may be offered to the customer in exchange for the change due. Hayashi does contemplate any such embodiments.

Engstrom (e.g., because it is non-analogous art directed to an entirely different field and endeavor than the art of vending machines) simply and entirely fails to make up for these deficiencies of Hayashi.

Accordingly, at least because Hayashi and Engstrom, alone or in combination, fail to teach or suggest *identifying a product offered for sale by the vending machine that is associated with a minimum acceptable price that is less than or equal to the amount of change due to the consumer*, Hayashi and Engstrom fail to render obvious claim **81**. Applicants therefore respectfully request that this §103(a) ground for rejection of claim **81** be withdrawn.

K. No Prima Facie Case of Obviousness

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for

the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The Examiner simply provides *no explanation*, reasoning, or support for the contention that it would have been obvious to combine Hayashi and Engstrom. In other words, even if Hayashi and Engstrom taught and suggested, in combination, every limitation of the pending claims (which Applicants maintain they do not), the pending claims would nonetheless be allowable at least because the Examiner has not even attempted to set forth a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn.

L. Non-Analogous References

Engstrom is a reference pertaining to the art of variable value retail coupons. Engstrom is not related to vending machines, sales at vending machines, or even to sales at all. Nor is Engstrom directed to solving any problem coincident with either the present disclosure or Hayashi.

Accordingly, at least because Hayashi and Engstrom are directed to different fields of endeavor and are not directed to solving the same problem, Hayashi and Engstrom are non analogous references and Applicants therefore respectfully request that this §103(a) ground for rejection be withdrawn.

V. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 461-7017 or via e-mail at cfincham@walkerdigital.com, upon the Examiner's convenience.

VI. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

February 23, 2007
Date

/Carson C.K. Fincham, Reg.#54096/
Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital Management, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7300 /fax